

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:)	
)	
BROWNING et al)	Group Art Unit: 1645
)	
Application No.: 10/077,137)	Examiner: Patricia Duffy
)	
Filed: February 15, 2002)	Confirmation No. 2907
)	
For: BAFF RECEPTOR (BCMA), AN)	
IMMUNOREGULATORY AGENT)	

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

APPLICATION FOR PATENT TERM ADJUSTMENT-PRE-GRANT

In accordance with 37 C.F.R. § 1.705(b), Applicant hereby applies for patent term adjustment under 35 U.S.C. § 154(b) of 855 days. This application is being filed before or with the issue fee payment, as required by 37 C.F.R. § 1.705(b).

I. Statement of the Facts Involved

A. Correct Patent Term Adjustment

Applicants received the Determination of Patent Term Adjustment with the Notice of Allowance and Fees Due mailed from the Patent and Trademark Office (PTO) on April 13, 2009, advising that this application is entitled to 253 days of patent term adjustment.

Applicants have calculated a patent term adjustment of 855 days based on the following facts:

Relevant Dates

The above-identified application was filed February 15, 2002.

The PTO mailed a first Office Action, which was a Restriction Requirement, on September 27, 2004, resulting in a PTO delay of 531 days beyond the 14 months provided by 35 U.S.C. § 154(b).

Applicants filed a response on December 17, 2004.

The PTO mailed a second Office Action on March 17, 2005.

Applicants filed a response on July 18, 2005, with a certificate of mailing under 37 C.F.R. § 1.8. It was received by the PTO on July 20, 2005, resulting in a delay of 33 days beyond the 3 months provided by 35 U.S.C. § 154(b).

The PTO mailed an Office communication on October 7, 2005, alleging that Applicant's reply was non-responsive because the "electronic file is missing attachments 6-11 as set forth in the amendment and response . . . The Examiner respectfully requests a second copy of the evidence previously presented as attachments 6-11 so that Applicants' reply can be considered." Office communication of October 7, 2005, at 2 (emphasis added).

Applicants filed a reply on November 7, 2005, noting that attachments 6-11 were present in the Image File Wrapper available on Public PAIR, under "Foreign Reference," Mail Room Date July 20, 2005, pages 46-65. Applicants also noted that they had spoken with the Examiner and that she had acknowledged the completeness of the response as originally filed. Applicants asked that the Office Communication of October 7, 2005, be withdrawn and that the amendment be entered as originally filed on July 18, 2005.

The PTO mailed a final Office Action on February 14, 2006. It noted that the “response and amendment filed 7-20-05 has been entered into the record.”

The Patent Term Adjustment History lists an Applicant delay of 110 days for the reply of November 7, 2005 (in addition to the delay of 33 days for the original response received July 20, 2005). Applicants believe that the PTO has erred by assigning any Applicant delay to the reply of November 7, 2005. As the PTO has acknowledged, the response received July 20, 2005, was complete as originally filed. The Office erred by issuing a Communication alleging that Applicants’ reply was non-responsive. Moreover, that Communication expressly requested Applicants to provide “a second copy of the evidence previously presented.” Submission of a supplemental reply or other paper expressly requested by the Examiner after a reply has been filed does not constitute a failure of the Applicant to engage in reasonable efforts to conclude processing or examination of an application. See 38 C.F.R. § 1.704(c)(8).

Because Applicants’ response was complete as originally received by the PTO on July 20, 2005, the mailing of a final Office action on February 14, 2006, results in a PTO delay of 86 days beyond the 4 months provided by 35 U.S.C. § 154(b).

Applicants filed a Request for Continued Examination (RCE) on June 14, 2006, with a certificate under 37 C.F.R. § 1.10 of mailing by “Express Mail,” resulting in a delay of 31 days beyond the 3 months provided by 35 U.S.C. § 154(b).

The PTO mailed a first Office Action after the RCE on September 20, 2006.

On September 29, 2006, however, the PTO remailed the Office Action with a Letter Restarting the Period for Response. The PTO noted that it had previously mailed the Office Action “under an inappropriate cover sheet.”

Applicants filed a response to the first Office Action after the RCE on March 28, 2007. Measured relative to the mailing date of the Letter Restarting the Period for Response, this results in a delay of 89 days beyond the 3 months provided by 35 U.S.C. § 154(b). Applicants note that the Patent Term Adjustment History lists a delay of 98 days for this response. That calculation appears to be based on the mailing date of the Office Action (September 20, 2006), rather than the mailing date of the Letter Restarting the Period for Response (September 29, 2006). It is believed that the delay should be calculated relative to the mailing date of the Letter Restarting the Period for Response, since it was the Examiner who restarted the statutory period for response.

The PTO mailed a final Office Action on June 14, 2007.

Applicants filed an RCE on October 31, 2007, resulting in a delay of 47 days beyond the 3 months provided by 35 U.S.C. § 154(b).

The PTO mailed a first Office Action after the RCE on May 14, 2008, resulting in a delay of 75 days beyond the 4 months provided by 35 U.S.C. § 154(b).

Applicants filed a response to the first Office Action after the RCE on September 17, 2008, resulting in a delay of 34 days beyond the 3 months provided by 35 U.S.C. § 154(b).

The PTO mailed a final Office Action on December 31, 2008.

Applicants filed a response to the final Office Action on March 26, 2009.

The PTO mailed a Notice of Allowance on April 13, 2009.

Calculation of Patent Term Adjustment

As set forth above, the total PTO delay under 35 U.S.C. § 154(b)(1)(A) is 692 days, and the total reduction for Applicant delay under 35 U.S.C. § 154(b)(2)(C) is 234 days.

Because Applicants filed an RCE, it is possible to calculate the PTO's delay under 35 U.S.C. § 154(b)(1)(B) ("the 3 year pendancy rule") without knowing the issue date. The 3 year pendancy delay is equal to the number of days in the period beginning on the day after the date that is three years after the filing date of the application (February 16, 2005) and the day before the first RCE was filed (June 13, 2006). See 35 U.S.C. § 154(b)(1)(B)(i) and 38 C.F.R. § 1.703(b)(1). Accordingly, the PTO's delay under the 3 year pendancy rule of 35 U.S.C. § 154(b)(1)(B) is 483 days. Of these, 86 days overlap with the PTO's delay under 35 U.S.C. § 154(b)(1)(A).

Under *Wyeth v. Dudas*, 580 F. Supp. 2d 138 (D.D.C. 2008), the total PTO delay is calculated as the sum of the PTO's delays under 35 U.S.C. § 154(b)(1)(A) and 35 U.S.C. § 154(b)(1)(B), minus any days of those two delays that overlap. Thus, the total PTO delay is (692 days of examination delay + 483 days of 3 year pendancy delay) - 86 overlap days, which is 1089 days.

The total patent term adjustment is equal to the total PTO delay minus the Applicant delay. Thus, the correct Patent Term Adjustment in this case is $1089 - 234 = 855$ days. Applicants respectfully request that the current patent term adjustment be reconsidered.

B. Terminal Disclaimer

The above-identified application is not subject to a Terminal Disclaimer.

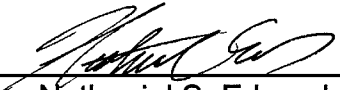
II. Fee

As required by 37 C.F.R. § 1.705(b)(1), please charge \$200.00 to Deposit Account 06-0916 to cover the fee required under 37 C.F.R. § 1.8(e). If there are any other fees due in connection with the filing of this request, please also charge them to Deposit Account 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
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Dated: July 10, 2009

By: 
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